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LEYDIG VOIT & MAYER, LTD
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180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

EXAMINER

RAMACHANDRAN, UMAMAHESWARI

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/047,817
Filing Date: January 15, 2002
Appellant(s): BROWN, RICHARD ALLEN

MAILED
AUG 17 2007
GROUP 1600

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/22/2007 appealing from the Office action mailed 10/19/2006.

Art Unit: 1617

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5599533	Stepniewski	2-1997
5730991	Rapaport	3-1998
5882661	Dorogi et al	3-1999
5656672	Collin et al	8-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1617

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 7-9, 11-32 and 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al. (US 5,599,533) in view of Rapaport (US 5,730,991), and further in view of Dorogi et al. (US 5,882,661).

Stepniewski et al. teach a stabilized water-in-oil emulsion comprising an organopolysiloxane elastomer (0.1 to 12% by weight), a vehicle (1 to 90% by weight), at least one stabilizing agent selected from the group consisting of electrolytes, a polyol, an alcohol, a hydrocolloid and mixtures thereof (0.01 to 20% by weight), at least one surfactant (0.01 to 20% by weight), and an aqueous component (claim 1; column 2, lines 20-35). Stepniewski et al. teach a make-up composition comprising said emulsion and at least one pigment (claim 31). Stepniewski et al. exemplify a cosmetic foundation comprising said emulsion (Example 2). Stepniewski et al. exemplify the same preferred elastomers as are preferred in the instantly claimed compositions (see column 2, lines 36-55 of Stepniewski et al. and p. 10, line 27-p. 11, line 12 of the instant specification). Stepniewski et al. teach that the vehicle preferably comprises a silicone oil (column 3, lines 1-20). Stepniewski et al. exemplify cyclomethicone, dimethicone, and mixtures thereof as preferred silicone oils (column 2, lines 66-67 and column 3, lines 1-20). Stepniewski et al. teach that preferred electrolyte stabilizing agents are "alkali metal salts and alkaline earth salts, especially the chloride, borate, citrate, and sulfate salts of sodium, potassium, calcium and magnesium" (column 3, lines 46-54). Stepniewski et al. teach that other preferred stabilizers include "organo-modified clays such as quaternium-18-hectorite." (column 4, lines 3-4). Stepniewski et al. teach that the

Art Unit: 1617

hydrocolloid includes thickening agents (column 3, lines 55-57). Stepniewski et al. teach that cetyl dimethicone copolyol is a preferred surfactant (claim 40; column 4, lines 26-28; Example 1). Stepniewski et al. teach that the aqueous phase should constitute 10-60% by weight, and preferably 30-45% by weight, of the emulsion (column 4, lines 54-56). Stepniewski et al. teach that the composition can comprise other additives, including "glycols... sunscreen agents... preservatives, such as known parabens" (column 4, line 63-column 5, line 2). Stepniewski et al. teach that when the emulsion is used as a make-up, pigments are included (column 5, lines 2-3). Stepniewski et al. exemplify iron oxides and titanium dioxide as preferred pigments (claim 32; column 5, lines 3-7; Example 2).

Stepniewski et al. do not teach octyl methoxycinnamate as a preferred sunscreen agent. Stepniewski et al. do not teach the preferred herein claimed preservatives phenoxyethanol, methylparaben or propylparaben. Stepniewski et al. do not teach that the compositions comprising the emulsion are stable for at least three months at about 50 °C.

Rapaport teaches that octyl methoxycinnamate is a preferred sunscreen agent for use in topical compositions (column 17, lines 17-26).

Dorogi et al. teach that phenoxyethanol, methyl paraben and propyl paraben are preferred preservatives for use in topical compositions (column 5, lines 17-19).

It would have been obvious to a person of ordinary skill in the art to add octyl methoxycinnamate as a sunscreen agent and phenoxyethanol, methylparaben or

Art Unit: 1617

propylparaben as a preservative to the compositions of Stepniewski et al. to arrive at the instantly claimed compositions.

The person of ordinary skill in the art would have been motivated to add octyl methoxycinnamate to the compositions of Stepniewski et al. because Rapaport teaches that octyl methoxycinnamate is a preferred sunscreen agent for use in topical compositions. The person of ordinary skill in the art would have been motivated to incorporate phenoxyethanol, methylparaben or propylparaben into the compositions of Stepniewski et al. as preservatives because Dorogi et al. teach that phenoxyethanol, methyl paraben and propyl paraben are preferred preservatives for use in topical compositions. The person of ordinary skill in the art would have expected success in incorporating the herein claimed sunscreen agents and preservatives because Stepniewski et al. disclose broadly the incorporation of sunscreen agents and preservatives, including known parabens, and Rapaport and Dorogi et al. teach that the herein claimed sunscreen agents and preservatives have been successfully used in topical compositions. Further, although Stepniewski et al. do not teach that the compositions are "stable for at least three months at about 50 °C," they do disclose that the compositions are stable in general. The recitation that the instantly claimed compositions are "stable for at least three months at about 50 °C" is an inherent feature of the product rendered obvious by the teachings of the prior art. It has been established that "[m]ere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention." (See MPEP § 2145, "II. Arguing Additional Advantages or Latent Properties"). It has also been established that "[g]ranting a patent

Art Unit: 1617

on the discovery of an unknown but inherent function... 'would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art.'" See MPEP § 2145, "II. Arguing Additional Advantages or Latent Properties").

Because all of the components of the herein-claimed topical compositions have been disclosed in the prior art for incorporation into topical compositions, the optimization of the amount of the components is not considered inventive because it is a matter of routine experimentation for the skilled artisan possessing the above-cited prior art. Applicant's attention is directed to *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) which states, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See MPEP § 2144.05, "II. Optimization of Ranges".

Claims 1, 7-9, 11-32 and 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al., Rapaport, and Dorogi et al. as applied to claims 1, 7-9, 11-32 and 53-58 above, and further in view of Collin et al. (US 5,656,672).

Stepniewski et al. teach the water-in-oil emulsions comprising, among other things, sunscreen agents, preservatives, and 0.01-20% by weight of the preferred surfactant cetyl dimethicone copolyol, as outlined above.

As stated above, Rapaport teaches that octyl methoxycinnamate is a preferred sunscreen agent for use in topical compositions, and Dorogi et al. teach that phenoxyethanol, methyl paraben and propyl paraben are preferred preservatives for use in topical compositions.

Art Unit: 1617

Stepniewski et al., Rapaport, and Dorogi et al. do not teach incorporation of the surfactant cetyl dimethicone copolyol at the herein claimed range of 3-6% by weight.

Collin et al. teach water-in-oil compositions which preferably comprise "a silicone-containing emulsifying agent, which is used in a proportion of from 0.5% to 10%, and preferably from 1% to 6%, of the total weight of the emulsion." (column 3, lines 36-49). Cetyl dimethicone copolyol (also ABIL EM-90) is exemplified as a preferred emulsifying agent (claim 16; column 3, lines 36-49; Examples 2 and 4). Collin et al. exemplify two cosmetic compositions wherein the amount of cetyl dimethicone copolyol is 3% by weight of the composition (Examples 2 and 4).

It would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate octyl methoxycinnamate as a sunscreen agent and phenoxyethanol, methylparaben or propylparaben as a preservative into the compositions of Stepniewski et al., and to add cetyl dimethicone copolyol at the herein-claimed ranges, to arrive at the instantly claimed compositions.

The person of ordinary skill in the art would have been motivated to incorporate octyl methoxycinnamate, phenoxyethanol, methylparaben, and propylparaben in the compositions of Stepniewski et al. and would have expected success for the reasons stated above. The person of ordinary skill in the art would have been motivated to incorporate cetyl dimethicone copolyol in the compositions of Stepniewski et al. at the herein claimed ranges because Collin et al. teach that 1 to 6% by weight is a preferred range for the surfactant in water-in-oil emulsions, and because Collin et al. exemplify the incorporation of cetyl dimethicone copolyol at 3% by weight in two different cosmetic

Art Unit: 1617

compositions. The person of ordinary skill in the art would have expected success because Stepniewski et al. teach that cetyl dimethicone copolyol can be incorporated at 0.01 to 20% by weight of stable water-in-oil emulsions, and Collin et al. teach that 1 to 6% by weight, and specifically 3% by weight, is a preferred range of cetyl dimethicone copolyol from within the range taught by Stepniewski et al. for use in water-in-oil-emulsion-based cosmetic compositions.

(10) Response to Argument

Claims 1, 7-9, 11-32 and 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al. (US 5,599,533) in view of Rapaport (US 5,730,991), and further in view of Dorogi et al. (US 5,882,661).

The Appellant argues, "Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%." In response, the references Rapaport and Dorogi et al. were provided as motivation to incorporate the herein-claimed sunscreen agent octyl methoxycinnamate and the herein-claimed preservatives phenoxyethanol, methylparaben or proylparaben into the compositions of Stepniewski et al. No other reference is needed to motivate the person of ordinary skill in the art to incorporate cetyl dimethicone copolyol into the compositions of Stepniewski et al. because Stepniewski et al. teach that cetyl dimethicone copolyol is a preferred surfactant for their compositions (claim 40; column 4, lines 26-28; Example 1).

The Appellant argues, that the instantly claimed compositions are not obvious in view of the combined reference because Applicant has discovered that incorporation of the emulsifier cetyl dimethicone copolyol in the range of 3-6% by weight has improved stability relative to other concentrations of the emulsifier that are within the range disclosed by Stepniewski et al. In response, Applicant points to the Declaration filed under CFR 37 § 1.132 on August 9, 2006, as evidence of an enhanced stability of compositions comprising the herein-claimed concentrations of cetyl dimethicone copolyol relative to compositions comprising concentrations of the emulsifier that are within the range disclosed by Stepniewski et al. The Examiner acknowledges that the Declaration indicates an enhanced stability of the instantly claimed composition comprising cetyl dimethicone copolyol at 3-6% by weight relative to similar compositions that comprise concentrations of cetyl dimethicone copolyol outside of the herein-claimed range, but within the range disclosed by Stepniewski et al. It is a matter of routine experimentation to test various concentrations of the emulsifier from within the range taught by Stepniewski et al. to arrive at the optimal range from within the broad disclosure. Applicant's attention is directed to *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) which states, "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." See MPEP § 2144.05, "II. Optimization of Ranges".

Art Unit: 1617

Claims 1, 7-9, 11-32 and 53-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stepniewski et al., Rapaport, and Dorogi et al. as applied to claims 1, 7-9, 11-32 and 53-58 above, and further in view of Collin et al. (US 5,656,672).

The Appellant argues, that Rapaport and Dorogi et al. do not provide motivation for the addition of cetyl dimethicone copolyol in an amount of about 3-6 wt%. In response, as mentioned above, the references Rapaport and Dorogi et al. were provided as motivation to incorporate the herein-claimed sunscreen agent octyl methoxycinnamate and the herein-claimed preservatives phenoxyethanol, methylparaben or proylparaben into the compositions of Stepniewski et al. No other reference is needed to motivate the person of ordinary skill in the art to incorporate cetyl dimethicone copolyol into the compositions of Stepniewski et al. because Stepniewski et al. teach that cetyl dimethicone copolyol is a preferred surfactant for their compositions.

The Appellant argues, that there simply is no connector between the cited references that would lead one of ordinary skill in the art to provide the composition of the claimed invention. In response, Stepniewski et al. teach the water-in-oil emulsions comprising, among other things, sunscreen agents, preservatives, and 0.01-20% by weight of the preferred surfactant cetyl dimethicone copolyol. Collin et al. teach water-in-oil compositions which preferably comprise "a silicone-containing emulsifying agent, which is used in a proportion of from 0.5% to 10%, and preferably from 1% to 6%, of the total weight of the emulsion and cetyl dimethicone copolyol is exemplified as a preferred emulsifying agent. The reference teaches two cosmetic compositions wherein the amount of cetyl dimethicone copolyol is 3% by weight of the composition. The

Art Unit: 1617

references are connected to each other in the preparation of oil in water emulsions (cosmetic compositions) and both teach cetyl dimethicone copolyol as an emulsifier. The emulsion is stabilized by the inclusion of the emulsifier cetyl dimethicone copolyol. Applicant acknowledges that the cetyl dimethicone copolyol is added as an emulsifier. The person of ordinary skill recognizes that the function of an emulsifier is to stabilize an emulsion. For instance, see www.ucalgary.ca/~schramm/emulsion.htm, which defines an emulsifier as, "An agent that acts to stabilize an emulsion. The emulsifier may make it easier to form an emulsion and to provide stability against aggregation and possibly against coalescence." Thus, by Applicant's own admission, in view of the art-recognized definition of emulsifier, the cetyl dimethicone copolyol was added to the compositions of Collin et al. to stabilize the emulsion. Further, Collin et al. exemplify a concentration of the emulsifier cetyl dimethicone copolyol that is within the herein-claimed range. Thus, the person of ordinary skill in the art would understand upon viewing Collin et al. that cetyl dimethicone copolyol could be incorporated into water-in-oil emulsions at the herein-claimed range in order to achieve enhanced stability of the emulsion.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 1617

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

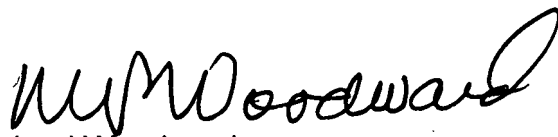
Conferees:



Sreeni Padmanabhan

Supervisory Patent Examiner

AU 1617



Michael Woodward

Supervisory Patent Examiner

AU 1615



Umamaheswari Ramachandran

Examiner AU 1617

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